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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,498	08/02/2006	Ronald Rodriguez	59563(71699)	3398

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EXAMINER

GUDIBANDE, SATYANARAYAN R

ART UNIT	PAPER NUMBER
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1654

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/523,498		RODRIGUEZ ET AL.	
	Examiner		Art Unit	
	Satyanarayana R. Gudibande		1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-30, 32-34 is/are rejected.
- 7) ☒ Claim(s) 8 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of group II invention and SEQ ID NO: 1 as the species and in the reply filed on 12/08/06 is acknowledged.

Examiner searched SEQ ID NO: 1 and found to be free of art and examiner extended the search and found art on SEQ ID NO: 9.

Claims 8 and 28-34 are pending.

Claims 8 and 28-34 are examined on the merit.

Claims 1-7 and 927 have been canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-30, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/61605 of Heston, et al.

In the instant application, applicants claim a peptide compound, which selectively binds to the extracellular portion of the human PSMA and comprises at least 5 residues in common with the consensus sequence QKHHNYL (SEQ ID NO: 109).

Heston, et al., discloses a PSMA-like protein sequence (SEQ ID NO: 2) particularly the region of the protein amino acid positions 218-245 that contains the 6 amino residues of SEQ ID NO: 109 of the instant application. The reference discloses that the protein sequence of SEQ ID NO: 2 has been used for diagnostic purposes for imaging the cells expressing the prostate specific membrane antigen (PSMA) or prostate specific membrane antigen-like (PSMA-like) protein. This procedure of binding of the PSMA-like protein to the cell surface clearly indicates that the SEQ ID NO: 2 binds to the extracellular portion of the cell expressing PSMA or PSMA-like protein (page 15, lines 22-28). Amino acid position 158 and position 289 has cysteine amino acids and hence can form a cyclic peptide via disulfide linkage in SEQ ID NO: 2 of the reference meeting the limitations of claim 31 and 33. Thus the presence of 6 amino acid residues of SEQ ID NO:109 of the instant application in SEQ ID NO: 2 of the reference and binding characteristics of the SEQ ID NO: 2 to the PSMA expressing cells meets the limitations of claims 28-30 and 32.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 28 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the instant application, applicants claim a peptide compound, which selectively binds to the extracellular portion of the human PSMA and comprises at least 5 residues in common

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with the consensus sequence QKHHNYL (SEQ ID NO: 109) wherein the peptide comprises of one or more amino acid analogues.

From the recitation of the claims it is unclear as to the nature of the peptide analogs, number of amino acids analogs in the peptide and the positions at which the analogs are inserted in the peptide. Neither the claims nor the specification indicate what these analogs are and how many of these analogs are present in the peptide. Therefore, the claims as recited are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Allowable Subject Matter

Claims 8 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

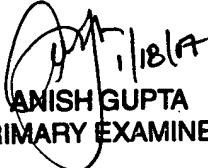
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satyanarayana R. Gudibande whose telephone number is 571-272-8146. The examiner can normally be reached on M-F 8-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satyanarayana R. Gudibande, Ph.D.
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ANISH GUPTA
PRIMARY EXAMINER